(23)

In the Supreme Court

OF THE

United States

October Term, A. D. 1943

No. 651

S. DUKE, doing business under the name and style of ROOSEVELT CHAIR & SUPPLY COMPANY,

Petitioner,

vs.

HERBERT A. EVEREST, and HARRY C. JENNINGS,

Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

FRED H. MILLER,
706 Central Building,
Los Angeles, California.

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

This case is but an ordinary patent infringement suit wherein the defendant (petitioner) Sam Duke, a former distributor of the plaintiffs' patented wheel chairs (R. 59) decided to discontinue doing business

with the plaintiffs and to manufacture and sell wheel chairs embodying plaintiffs' patented inventions himself. For such conduct plaintiffs duly notified defendant of his infringement (R. 70-71) and upon his refusal to discontinue, brought this suit for infringement.

The District Court after hearing and receiving the evidence held that both of plaintiffs' patents No. 2,095,411 and 2,181,420 were valid and infringed as to the claims in issue and entered appropriate findings of fact and conclusions of law (R. 131).

Defendant appealed to the Circuit Court of Appeals in and for the Seventh Circuit, which court after hearing, affirmed the decision of the District Court as to both infringement and validity, (opinion reproduced at R. pp. 226, et seq.).

This petition is filed by petitioner in the hope that This Court will review and disagree with the decisions of the District Court and the Circuit Court of Appeals in and for the Seventh Circuit.

There is no conflict of decision with respect to the plaintiffs' patents between two Circuit Courts of Appeal, nor does the case involve any principle, the settlement of which is of importance to the public.

In *Layne & Bowler Corp. v. Western Well Works, Inc.*, 261 U. S. 387; 314 O. G. 177, This Court said:

". . . It is very important that we be consistent in not granting the Writ of Certiorari

except in cases involving principles, the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal."

In *Keller v. Adams Campbell Co.*, 244 U. S. 314, 327 O. G. 217, This Court said:

> "Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this court will not bring here by certiorari, unless it be necessary to reconcile decisions of the Circuit Courts of Appeal on the same patent."

Again in *General Talking Pictures v. Western Electric Co., Inc.*, 304 U. S. 175, it is said:

> "Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it." . . .
>
> "Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues, for as to them there is no conflict between decisions of the Circuit Courts of Appeals."

Petitioner urges that an exception be made to the general rule as above announced because:

1. That the patents in suit relate to folding wheel chairs which will probably be used in increasing num-

bers by injured members of the armed forces of the United States;

2. That the lower courts erred in determining that the plaintiffs' patents are valid and have been infringed by the defendant, and

3. That as the defendant is the only present infringer of plaintiffs' patents, there is little likelihood of another case being prosecuted in a different circuit.

None of these reasons justify granting the Writ of Certiorari sought.

Plaintiffs do not pretend to be the originators of invalid wheel chairs. Such chairs were in existence long before plaintiffs made their inventions. The plaintiffs do not have nor do they claim to have any monopoly on invalid wheel chairs. Other chairs which sufficed for the purpose were in existence long before plaintiffs made their inventions. The plaintiffs do not have nor do they claim to have any monopoly on invalid wheel chairs which would inconvenience returning invalid soldiers who may have occasion to use the same. The plaintiffs have developed and patented two meritorious improvements in wheel chairs and are entitled to a just reward therefor as afforded by the patent laws of the United States. The defendant herein, as well as others, can freely manufacture and sell by merely dispensing with the use of plaintiff's patented improvements. Defendant has characterized in his petition these improvements as being mere "looseness or 'play' ". To avoid infringement, all the defendant has

to do is to eliminate such "looseness or play." Had the defendant chosen not to incorporate the plaintiffs' inventions in his infringing wheel chair and had he been content to manufacture and sell wheel chairs of other designs, which are not in issue herein, but which are illustrated in his catalog (R. p. 123) this suit would not have been brought nor would the plaintiffs have had a case of infringement.

Petitioner's plea that the effect of the decisions below unjustly gives to the plaintiffs a monopoly which will operate to the detriment of the armed forces of the United States and to the public at large, is not only untrue, but is in derogation of the fact that the defendant himself has filed an application for a patent on a wheel chair apparently identical with the patents in suit (R. pp. 72-77). Furthermore, the defendant herein claims to have acquired title to the Hayes patent, No. 1,898,834 reproduced in the record at p. 198 and has charged the plaintiffs with infringement of the Hayes patent by reason of plaintiffs having manufactured and sold wheel chairs embodying the inventions of the patents in suit. See the letter reproduced herein in the appendix hereto. We do not feel that it is proper for the defendant to petition this court for a writ of certiorari based on an allegation that the plaintiffs have secured a patent monopoly on folding wheel chairs that invalid soldiers might use, when the defendant himself is endeavoring to acquire and assert a similar monopoly.

In so far as the petition seeks a Writ of Certiorari, on the ground that plaintiffs' patents lack invention, the writ should be denied. This Court has already determined that it will not grant Certiorari merely "to review the questions of anticipation and invention" (*General Talking Pictures v. Western Electric Co. Inc.* supra). In the absence of conflict between Circuit Courts of Appeals, the lower courts here must be presumed to have properly applied the law and the standards of invention heretofore indicated by This Court's decisions, to the facts touching upon these questions as presented before them herein.

Nor is the defendant correct in asserting that the Circuit Court of Appeals acted in conflict with *McCarthy v. Lehigh Valley R. R. Co.*, 160 U. S. 110. The Circuit Court of Appeals herein has not read into claim 1 of Patent No. 2,091,411, any elements or limitations to save it from anticipation. On the contrary as stated by the Circuit Court of Appeals (R. 228):

> "It is true that claim 1 merely recites a folding chair but for reasons heretofore stated *that fact does not render the cited art any more pertinent.*" (Italics added.)

Consequently this claim was not anticipated, regardless of whether it claimed "A folding chair . . . " as stated, or "A folding propulsion wheel chair . . . " which might have been better.

The holding of the Circuit Court of Appeals, instead of being inconsistent, is thus in harmony with

that portion of *McCarthy v. Lehigh Valley R. R. Co.* reading " . . . this may be done with the view of *showing the connection in which a device is used* and proving it is an operative device. . . . " (Italics added.)

The Circuit Court of Appeals was therefore justified in construing the claim as being drawn to a folding wheel chair in view of the title, the disclosure and the drawings.

Finally, petitioner seeks a Writ of Certiorari on the ground that there is little likelihood of a conflict of decision between Circuit Courts of Appeal, because, except for plaintiffs, petitioner is "the only other manufacturer of folding wheel chairs of the character involved in this litigation in the United States or elsewhere."*[1] (Petitioner's affidavit in appendix to petition.) The answer to this contention is that the plaintiffs and defendant are not the only manufacturers of wheel chairs. Neither manufacture nor infringement are exclusively in the Seventh Circuit. Plaintiffs have heretofore brought suit against a Mr. McDonald at San Diego, California (R. 68) and will hereafter institute suit for infringement of their patents whenever or wherever occasion requires.

Manufacture of wheel chairs is not confined to the Seventh Circuit as in the case of *Exhibit Supply Co. v. Ace Patents Corporation*, 315 U. S. 126. Plaintiffs,

*1—It would almost necessarily follow that this case presents no question "the settlement of which is of importance to the public as distinguished from that of the parties." At least no such question is pointed out in the petition.

themselves, manufacture and sell in Los Angeles, California. Aside from McDonald in San Diego, California and this defendant in Chicago, Illinois, plaintiffs' patents have generally been respected throughout the United States and there has been no other infringement to plaintiffs' knowledge. Consequently there has been no occasion to sue, in any other than the Seventh and Ninth Circuits. In the absence of a showing that manufacture of invalid wheel chairs is largely confined to the Seventh Circuit, this ground for petitioning for Writ of Certiorari is untenable.

It is therefore submitted that both the District Court and the Circuit Court of Appeals have properly decided this litigation and that no recognized ground for granting a Writ of Certiorari exists. The petition should therefore be denied.

Respectfully submitted,

FRED H. MILLER,
706 Central Building,
Los Angeles 14, California.

Of counsel:
BERTRAM WM. COLTMAN,
77 W. Washington Street,
Chicago, Illinois.

WALLACE AND CANNON
ATTORNEYS AND COUNSELLORS AT LAW
PATENTS AND TRADE MARKS
ONE NORTH LA SALLE STREET
CHICAGO 2

GEO. H. WALLACE
CHARLES B. CANNON
FERD BING

SELY. WALLACE AND CANNON
1937 - 1940

TELEPHONE
CENTRAL 5575 - 6
CABLE ADDRESS
WALCAN, CHICAGO

Thursday
December 30, 1943.

Everest and Jennings
1032 W. Ogden Drive
Los Angeles, California

Gentlemen:

Our client, Mr. Sam Duke, doing business as Roosevelt Chair & Supply Company, at 1220 South Michigan Avenue, Chicago, Illinois, is the owner of the entire right, title and interest in and to United States patent No. 1,898,834 granted February 21, 1933, on Chairs, in the name of Thomas R. Hayes, together with all rights to recover for past infringement thereof.

Our attention has been called to the fact that you are manufacturing and selling folding wheel chairs, as exemplified by your so-called "Traveler" and "Universal" models which, in our judgment, infringe claim 4 of this patent.

Accordingly, in behalf of our client, we are authorized to and do hereby notify you as to claim 4 of the above identified patent and call upon you to discontinue the manufacture and sale of the above identified or other folding wheel chairs deemed to infringe said claim and to account to our client for all profits and/or damages resulting from the manufacture, sale and use of such infringing folding wheel chairs.

Yours very truly,

WALLACE and CANNON

Charles B. Cannon

By Charles B. Cannon.

CBC:ID
cc
Reg. Ret. Recpt.